

## **STATUS OF THE CLAIMS**

Claims 1-38 are pending in the Application.

Claims 1-38 are rejected by the Examiner.

Claims 27-38 are objected to by the Examiner.

Reconsideration of the present Application is respectfully requested.

## **REMARKS**

### **Claims**

#### **Claim Rejections Pursuant to 35 U.S.C. §101**

##### **Claims 1-25 Rejection**

Claims 1-25 stand rejected under 35 U.S.C. 101 as being unpatentable as non-statutory subject matter.

35 U.S.C. 101 recites:

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”

The Supreme Court has stated that Congress intended statutory subject matter to “include anything under the sun that is made by man.” *See Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). The Supreme Court has also specifically noted exceptions to this and identified three categories of unpatentable subject matter. They are: “laws of nature, natural phenomena, and abstract ideas.” *See Diamond v. Diehr*, 450 U.S. 175, 185 (1981). Practical application falling outside the laws of nature, natural phenomena, or

abstract ideas is achieved when the claimed subject matter produces “a useful, concrete and tangible result.” *See State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02.

The Examiner argues that the present invention is “merely an abstract idea,” and that such ideas do not “apply, involve, [or] use the technological arts fail to promote the ‘progress of science and the useful arts’”. On the contrary, Applicant submits that the requirements of 35 U.S.C. 101 are satisfied if “the practical application of the abstract idea produces a useful, concrete and tangible result.” *In re Alappat*, 31 U.S.P.Q. 2d 1545, 1558 (Fed. Cir. 1994); *State Street Bank & rust Co. v. Signature Financial Group, Inc.*, 47 U.S.P.Q. 2d 1596, 1601-02 (Fed. Cir. 1998).

The pending application entails sophisticated methods for insuring risks in a restructured energy industry, and computer-implemented systems for generating an insurance policy for insuring against such risks. These sophisticated methods are explicitly set forth in Section 101 as being patentable subject matter, and hence cannot be considered abstract ideas by the Examiner. Further, the reduction of risk for the energy industry realized in an insurance policy in the present application is a useful, concrete and tangible result, therefore explicitly constituting patentable subject matter in light of *State Street Bank*. Applicant would also like to remind the Examiner that the claims herein were previously allowed by the Examiner.

Consequently, Applicant traverses the 35 U.S.C. §101 rejection and respectfully requests its reconsideration and removal. Applicant asserts that independent Claim 1 is in a condition for allowance.

In addition, Applicant asserts that dependent Claims 2-25 are likewise in a condition for allowance, at least by virtue of the ultimate dependence on independent Claim 1.

## Claim Rejections Pursuant to 35 U.S.C. §112

### Claims 26 and 36-37 Rejection

Claim 26 stands rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 36-37 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to provide a distinguishing level of exclusion causing the claims to be vague and ambiguous. Applicant traverses these rejections and deems them overcome for at least the following reasons:

MPEP §2172 (I) recites:

A rejection based on the failure to [particularly point out and distinctly claim the subject matter which applicant regards as his invention] is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). Emphasis added.

MPEP §2173.01 recites:

A fundamental principal contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their own invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, **alternative expressions**, negative limitations, or **any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought**. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

Examiner bases the rejection of Claim 26 on the premise that the claim language used may cause the claim to “fail/(not [be] true)”, thus rendering the claim indefinite for

failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. However, in accordance with MPEP § 2172 and 2173.01, if the claim fails, the Applicant does not regard the failed condition as new, novel, and non-obvious, and hence the claim covers only the true condition as new, novel, and non-obvious. Therefore, the claim is clear that Applicant regards only the “true” condition as Applicant’s invention. Examiner fails to identify references to support this improper rejection of the present application and thus, Examiner’s rejection is contrary to the requirements of *In re Moore*, *In re Swinehart*, and the MPEP.

With respect to Claims 36-37, the rejection proposes that there is no definitional support for “a distinguishing level of exclusion.” The language used in Claims 36-37, specifically uses terms of exclusion supported by the specification of the present application, and that language is used in a way that is not contrary to accepted meanings in the art. Thus, the language of claims 36-37 is not “vague and ambiguous,” and the conditional nature of the language is directed to claim coverage of only that which is new, novel, and non-obvious, as discussed above.

Therefore, Applicant respectfully submits that the above 35 U.S.C. §112 second paragraph rejection has been overcome.

### **Claim Rejections Pursuant to 35 U.S.C. §103**

#### **Claims 26-38 Rejection Over Cited Art**

Claims 26-38 stand rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over “New CIGNA Power Products Unit”, PR Newswire Association (July 27, 1998), in view of International Risk Management Institute, Inc. “Commercial Property Insurance” Volume III (1997); “CIGNA Special Risk Facilities and SOURCE Strategies Issues Retreat” Kane, Slide Presentation (1998); and “Not so Risky Business: An Increase in Insurance Capacity and an Improved Loss History are Leading to New Products and Approaches For The Chemicals Industry”, Fitzgerald, Chemical Marketing Reporter, V 250 N3 (July 15, 1996) and in further view of “Commercial Property Risk Management and Insurance – Vol. 1”, Rodda et al., pp. 282-284 (3<sup>rd</sup> edition 1998) and “Insurance

Principles and Practices – Insurance of Property - - Fire”, Riegel et al., pp. 536-537 and 542-543 (1966). Examiner states that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to implement a method of insurance of a particular electrical power into a floppy disk with suggestions from “New CIGNA Power Products Unit”, Insurance Services Office, Denis Kane, Fitzgerald., Rodda et al., and Riegel et al.’s references, because these information are specifically related in that [ . . . ] one MUST logically do in insurance business at least for efficiency and storage/retrieve purposes”.

Applicant traverses these rejections, and deems them overcome, for at least the reasons stated forth hereinbelow.

35 USC §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Accordingly, MPEP 706.02(j) states:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

New CIGNA Power Products Unit”, PR Newswire Association (July 27, 1998)

Applicant asserts that the July 27, 1998 CIGNA press release fails to teach or suggest all the claim limitations claimed subject matter of the present invention. The article does not describe any of the claim limitations of the present invention. The pending application entails sophisticated methods for insuring risks in a restructured energy industry, and computer-implemented systems for generating an insurance policy for insuring against such risks. For example, the assessment of the supplier’s system power, and/or the power from that system that the purchaser desires to purchase, prior to designating insurance prices, provides for market pricing control in that, if the supplier bears the risk of instantaneous replacement in the event of an outage, the market price for the purchaser will be higher than if the purchaser were to bear the risk. Conversely, the present invention allows for a decrease in market price wherein the purchaser agrees with the supplier that the purchaser is to bear this risk directly by insuring against a purchased-power shortfall. Thus, a supplier may seek insurance for system obligations to purchasers, rather than individual purchasers seeking to gain coverage for the effects of power shortfall on that purchaser, and the supplier may thereby indirectly, by increased market price mechanisms, pass only a portion of the costs for the instantaneous insurance against unplanned outages to purchasers, thereby eliminating direct insurance costs to the purchaser.

Further, this market-based insurance eliminates the need for a wait period on the part of the purchaser, during which the purchaser must go without power while a “named peril” event is cured by insurance, such as in the event that the purchaser waits for the purchaser’s insurance to take effect, or the purchaser’s insurer to locate needed power, or in the event that the purchaser awaits the repair or replacement, by the supplier’s insurer, of the devices that caused the power shortfall.

This market-based insurance is not shown or suggested in this article. The article does not, in any detail, discuss any of the elements of the claimed inventions as defined by the claims of the present application, and thus fails as a reference under 35 U.S.C. § 103 (a).

International Risk Management Institute, Inc. “Commercial Property Insurance”

Examiner asserts, in error, that materials available to the insurance industry by the International Risk Management Institute, Inc. (“IRMI”), in a loose-leaf book entitled “Commercial Property Insurance” Volume III, constitute prior art under 35 U.S.C. §102(b). 35 U.S.C. 102(b) states in part that “a person shall be entitled to a patent unless (b) the invention was . . . *described* in a printed publication in this . . . country, more than one year prior to [the filing date].” [emphasis added]. *Id.* None of the examples from the IRMI book describe, in any detailed, the invention claimed in the pending application.

The examples provided from the IRMI book refer to “Boiler and Machinery Insurance,” and include various policy provisions and forms. The cited reference points to policies and endorsements covering so-called “business interruption” and extra expense liabilities related to local power interruption. The explanation of these insurable objects, and the explanation of the purpose for the available coverages, i.e. local power interruption, does not describe the invention as claimed in the pending application in sufficient detail to enable one of skill in the art to make and/or use the invention.

For example, the IRMI book references specifically insurable on-site objects, such as equipment, and deals with local power interruption on a local catastrophic event basis, wherein a retail power company customer loses on-site generation capabilities, such as through the loss of a boiler. The power interruption insurance described by the IRMI is thus directed at retail users of electricity that may experience an interruption, such as a local interruption of power due to a local interruption caused by a catastrophic accident, such as on-site boiler or generator accident. Thus, the insurance coverage suggested by the IRMI book differs substantially from that of the pending application in that it does not describe predictable pricing of supplied power based on system risk assessment to insure against the possibility of variable costs.

Furthermore, Examiner fails to acknowledge that the insurance mechanisms of IRMI are taught against in the present invention. The IRMI book

discloses only local catastrophic event policies, consistent with typical types of insurance. In contrast, the pending application combines custom tailored risk management solutions for power supply risks, which are an innovative means of managing budgets, reducing costs and obtaining greater flexibility in the restructured electric power industry. The pending application provides methods and systems of insurance risks with predictable pricing based on risk assessment of price fluctuations in supply, rather than previously used traditional insurance market mechanisms. For example, the assessment of the supplier's system power, and/or the power from that system that the purchaser desires to purchase, prior to designating insurance prices, provides for market pricing control in that, if the supplier bears the risk of instantaneous replacement in the event of an outage, the market price for the purchaser will be higher than if the purchaser were to bear the risk. Conversely, the present invention allows for a decrease in market price wherein the purchaser agrees with the supplier that the purchaser is to bear this risk directly by insuring against a purchased-power shortfall. Thus, a supplier may seek insurance for system obligations to purchasers, rather than individual purchasers seeking to gain coverage for the effects of power shortfall on that purchaser, and the supplier may thereby indirectly, by increased market price mechanisms, pass only a portion of the costs for the instantaneous insurance against unplanned outages to purchasers, thereby eliminating direct insurance costs to the purchaser. Further, this market-based insurance eliminates the need for a wait period on the part of the purchaser, during which the purchaser must go without power while a "named peril" event is cured by insurance, such as in the event that the purchaser waits for the purchaser's insurance to take effect, or the purchaser's insurer to locate needed power, or in the event that the purchaser awaits the repair or replacement, by the supplier's insurer, of the devices that caused the power shortfall. This market-based insurance is not shown or suggested in the referenced art.

In other words, the present invention is not directed to an on-site power generator outage, but rather is directed to a risk assessment of the possibility of variable costs in the provision of an adequate supply of desired power output. The pending application is, unlike IRMI, not an "on-site generation" policy, but, rather, is a policy



directed to the receipt of power. Thus, the present invention provides for system coverage, wherein, for example, a system is insured for 10kW, and output drops to 9kW, and the present invention provides for coverage that starts at the time of the event, rather than at the time of on-site unit replacement. Examiner has failed to show that any of these methods and systems claimed in the pending application are described in the IRMI book.

CIGNA Special Risk Facilities and E-SOURCE Strategies Issues Retreat”, Kane, Slide Presentation (1998)

Examiner cites the photocopies of a slide seminar entitled E-Source Strategic Issues Retreat (“Retreat”) and raises the issue of obviousness with respect to the claimed subject matter.

Section 103 provides in part:

(c) Subject matter developed by center person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of Section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed inventions were, at the time of the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Thus, §103 (c) precludes the use of in-house §102 (e), (f) and (g) activity if the subject matter is patentable over prior art available outside the company. The inventor of the present invention was an employee at Cigna (now Ace, Ltd.) and a co-worker to Dennis Kane who is the identified author of the cited reference.

The presentation of the Retreat document was a restricted in-house document not authorized by ACE for distribution at the presentation. Copies of the Retreat document were not made for distribution, and the document was treated by ACE as confidential (*See* previously submitted Declaration of Ed Zaccaria). Consequently, the Retreat document was not accessible by the public or persons concerned with purchasing the insurance products to which the document relates. In fact, production of this document to the Patent Office may constitute a violation of contract and trade secret law on the part

of the Person who supplied the document (*See* Protest filed July 3, 2002; EL 564216621 US). Therefore, the presentation document cited by the Examiner and the present invention is subject to an obligation of assignment to Ace, Ltd. and fails as prior art under §103 (a).

Not so Risky Business: An Increase in Insurance Capacity and an Improved Loss History are Leading to New Products and Approaches For The Chemicals Industry, Fitzgerald, Chemical Marketing Reporter, V 250 N3 (July 15, 1996)

Examiner cites and article by Fitzgerald entitled “An Increase in Insurance Capacity and an Improved Loss History are Leading to New Products and Approaches For The Chemicals Industry” (“the Business article”) as a combination reference in the §103 (a) rejection. The Business article discusses changes occurring in the field of localized catastrophic insurance protection for chemical manufactures, and is not applicable to the pending application. The article fails to relate to the pending application because the insurance discussed insures actual property losses and associated physical consequences, and the “combined risks” approach relies on the company’s ability to fund its own losses through financial instruments.

The cited article does not insure against the type of loss contemplated by the pending application. The article discusses insurance for catastrophic events, such as “Piper Alpha, Exxon Valdez or the Phillip’s explosion.” In contrast, the pending application claims, in part, insurance against risks in an energy industry wherein an electrical power purchaser has, for example, an underlying power supply contract with a contracting power supplier, wherein the contracting power supplier has no obligation to supply electrical power to the electrical power purchaser in the case of the contracting power supplier not meeting all or part of the supplier’s power requirements under the supply power contract. The types of losses against which the pending application seeks to ensure are not “localized catastrophic losses,” but rather are “insufficient supply” circumstances, and correspondent market price controls, in a power supply system. For example, the assessment of the supplier’s system power and the power from that system that the purchaser desires to purchase, prior to designating insurance prices, and the

seeking of insurance for system obligations to purchasers, rather than a purchaser seeking to gain coverage for the effects of power shortfall on the purchaser, is not shown or suggested in the referenced art. Additionally, the events covered by the type of traditional insurance set forth in Business article are localized physical damage events, and thus are not the type of events insured by the pending application. The extent or nature of a catastrophe are not relevant to the claims of the pending application.

The Business article further describes the approach to catastrophic insurance coverage as a combination of traditional insurance coupled with a financial instrument. This type of risk coverage is a 'hedge' against a possible localized catastrophic equipment loss when and if the company's funds are low. Thus, in a sense, the "combined risks" approach of the Business article merely acts as a loan to the insured, allowing the insured to borrow from a "rainy-day fund" while "waiting for the storm". In the end, the "combined risks" approach, as defined in the Business article, does nothing more than insure against, at most, an infrequent, localized, on-site catastrophic event. This approach sharply contrasts the invention of the pending application. The present invention offers advantages over financial instruments and other traditional insurance solutions, due to its ability to provide price predictability, and market price control, for an overall power supply system for the possible necessity of additional supply. The pending application does not 'hedge' against catastrophic losses, and thus does not operate as a "loan" as taught in the Business article.

Commercial Property Risk Management and Insurance – Vol. 1”, Rodda et al., pp. 282-284 (3<sup>rd</sup> edition 1998)

The article cited by the Examiner entitled “Commercial Property Risk Management and Insurance – Volume I” (“Volume 1”) is directed to local property losses, unlike the present invention. The description for “Extra Expenses to Operate” in Volume 1 intuitively explains that a business interruption might require additional expenses to preserve income. Volume 1 uses the example of a psychiatrist who, while the damaged office of the psychiatrist is being refurbished, needs to rent a temporary office to continue business. This example succeeds in showing only common everyday

business economics involved in property losses, and does not illustrate a method and system of insuring system risks with predictable pricing based on risk assessment of the possibility of cost variability in power supply. For example, the assessment of the supplier's system power, and/or the power from that system that the purchaser desires to purchase, prior to designating insurance prices, provides for market pricing control in that, if the supplier bears the risk of instantaneous replacement in the event of an outage, the market price for the purchaser will be higher than if the purchaser were to bear the risk. Conversely, the present invention allows for a decrease in market price wherein the purchaser agrees with the supplier that the purchaser is to bear this risk directly by insuring against a purchased-power shortfall. Thus, a supplier may seek insurance for system obligations to purchasers, rather than individual purchasers seeking to gain coverage for the effects of power shortfall on that purchaser, and the supplier may thereby indirectly, by increased market price mechanisms, pass only a portion of the costs for the instantaneous insurance against unplanned outages to purchasers, thereby eliminating direct insurance costs to the purchaser. Further, this market-based insurance of the present invention eliminates the need for a wait period on the part of the purchaser, during which the purchaser must go without power while a "named peril" event is cured by insurance, such as in the event that the purchaser waits for the purchaser's insurance to take effect, or the purchaser's insurer to locate needed power, or in the event that the purchaser awaits the repair or replacement, by the supplier's insurer, of the devices that caused the power shortfall. This market-based insurance is not shown or suggested in the referenced art.

Insurance Principles and Practices – Insurance of Property - - Fire", Riegel et al., pp. 536-537 (1966).

Examiner cites the abovementioned reference which is asserted as being related to business interruption insurance. This same issue was raised above wherein Examiner cites the 1998 book "Commercial Property Risk Management and Insurance" Volume I. The explanation given in the present reference for "Extra Expenses Insurance" intuitively explains that a business interruption might require the payment of "extra

expenses” to preserve income. The author describes the insurance in connection with “physical damage” or a catastrophic event. *See* p. 542-43. This example succeeds in showing only common everyday business economics for insuring against property loss, and does not teach or suggest the method and system of insuring risks with predictable pricing based on risk assessment of the possibility of cost variability in power supply, based upon intended coverage limits set by the insurer, irrespective of whether the intended coverage limits are below, equal to, or in excess of, the “excess expenses” of the insured. For example, the assessment of the supplier’s system power, and/or the power from that system that the purchaser desires to purchase, prior to designating insurance prices, provides for market pricing control in that, if the supplier bears the risk of instantaneous replacement in the event of an outage, the market price for the purchaser will be higher than if the purchaser were to bear the risk. Conversely, the present invention allows for a decrease in market price wherein the purchaser agrees with the supplier that the purchaser is to bear this risk directly by insuring against a purchased-power shortfall. Thus, a supplier may seek insurance for system obligations to purchasers, rather than individual purchasers seeking to gain coverage for the effects of power shortfall on that purchaser, and the supplier may thereby indirectly, by increased market price mechanisms, pass only a portion of the costs for the instantaneous insurance against unplanned outages to purchasers, thereby eliminating direct insurance costs to the purchaser. Further, this market-based insurance of the present invention eliminates the need for a wait period on the part of the purchaser, during which the purchaser must go without power while a “named peril” event is cured by insurance, such as in the event that the purchaser waits for the purchaser’s insurance to take effect, or the purchaser’s insurer to locate needed power, or in the event that the purchaser awaits the repair or replacement, by the supplier’s insurer, of the devices that caused the power shortfall. This market-based insurance is not shown or suggested in the referenced art.

Thus, the above references cannot render obvious Claims 1 or 26 of the present invention. *MPEP 706.02(j) (... the prior art reference (or references when combined) must teach or suggest all claim limitations.)* Consequently, Applicant traverses the 35

U.S.C. §103(a) rejections and respectfully requests their reconsideration and removal. Applicant asserts that independent Claims 1 and 26 are in a condition for allowance.

Applicant respectfully submits that, in order to establish a prima facie 35 USC §103(a) rejection, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. MPEP 706.02(j). “The examiner can satisfy the burden of showing obviousness of the combination only by **showing some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art** would lead that individual to combine the relevant teachings of the references.” (emphasis added) In re Sang Su Lee, 00-1158, (Serial No. 07/631,240) , (Fed.Cir.2002) citing In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed.Cir.1992). Further, to establish a prima facie 35 USC §103(a) rejection **there must be a reasonable expectation of success**. MPEP 706.02(j). **Mere motivation is not sufficient.** In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and **may not be based on Applicant's disclosure.** In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Official Action states that it would have been obvious to a person having ordinary skill in the art to utilize and/or combine the referenced teachings. However, Applicant again respectfully notes that this motivation is **not specifically from within the references, or specifically shown as being apparent to one of ordinary skill in the art**. Applicant respectfully submits that a proper 35 USC §103(a) rejection requires **not that the Examiner provide the Examiner's motivation for the prior art combination asserted**, but rather that **the motivation from within the prior art itself be provided for the combination cited**. Applicant respectfully submits that **the prior art does not provide any motivation for the cited combination**, and that the only motivation provided to make the cited combination has been that of the Examiner.

The Federal Circuit, with regard to 35 USC §103(a) obviousness rejections, has made it clear that “[t]he need for specificity pervades.” See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir.2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner *claimed*” [emphasis added]). **In the instant case, no specificity has been provided** to support that one of skill in the art would have combined, or would have been motivated to combine, the relevant teachings of the references in the manner *claimed*, as has been repeatedly required by the Federal Circuit. “The factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.” In re Sang Su Lee, (Fed.Cir.2002).

The Federal Circuit, in In re Sang Su Lee, 00-1158, (Serial No. 07/631,240), (Fed Cir. 2002), reversed a rejection based on a motivation to combine. “Bozek did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. Bozek did not hold that objective analysis, proper authority, and reasoned findings can be omitted ... Nor does Bozek, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and Court of Customs and Patent Appeals that determination of patentability *must be based on evidence*.” (emphasis added ). Applicant respectfully submits that no objective evidence has been set forth in the Official Action as to any suggestion or motivation to combine the references as cited in the present Office Action, or that such a combination might present a reasonable expectation of success, and that this lack of evidence is adverse to the decision in Sang Su Lee.

Applicant thus respectfully submits that the skilled artisan would have found no motivated to combine the referenced teachings in the manner asserted, as the cited art itself provided neither a statement of such motivation, nor any evidence that such combination would have a reasonable likelihood of success. Applicant notes that the sole motivation provided appears to be that provided by the Examiner, not that provided in the prior art. **Applicant respectfully requests that, should the Examiner persist in**

the assertion that such motivation and reasonable expectation of success exists, and if the Examiner thereby intends to take judicial notice of such motivation and expectation of success, that the Examiner provide some evidence in the prior art that such a motivation and reasonable expectation of success is present in the prior art.

### **Dependent Claims**

In addition, Applicant asserts that dependent Claims 2-25 and 27-38 are likewise in a condition for allowance by virtue of the ultimate dependence on independent Claims 1 and 26.

### **Conclusion**

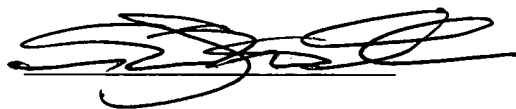
Applicants respectfully request reconsideration of the subject application in light of the reasons set forth herein, and a Notice of Allowance for all pending claims is earnestly solicited.

Respectfully Submitted,

**REED SMITH LLP**

Date:

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